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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/618,957 | 07/14/2003 | Mitsushi Yamamoto | UNIU79.013AUS | 6418 |

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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| EXAMINER |
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AHMAD, NASSER

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/618,957 | YAMAMOTO ET AL. | |
| | Examiner | Art Unit | |
| | Nasser Ahmad | 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I: Original claim 8 and newly submitted claims 9-12 are directed to a surface protective film; and

Group II: Newly submitted claim 13 is directed to a transparent conductive substrate.

Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as surface mat and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Rejections Maintained

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2. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by The English Abstract of Australian AU 9640808A of July 11, 1996 for reasons of record made in the last Office Action of March 31, 2006.

3. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra (5534374) for reasons of record made in the last Office Action of March 31, 2006.

Response to Arguments

4. Applicant's arguments filed 7/3/2006 have been fully considered but they are not persuasive.

Applicant argues that AU 9640808A reference does not disclose that any component of the adhesive polymer is transparent and is directed to "Partic. white polyester film is used in magnetic cards" and hence, is not directed to a transparent film. This is not found to be convincing because, as applicant correctly noted, the AU'808 reference has a **particular** embodiment that is of a white film. A complete copy of the AU'808 reference is attached with is Office Action.

The polyester film is understood to be inherently transparent as admitted by the applicant in the specification, page-2,

Then, surface protective films of heat-resistant high polyethylene terephthalate (PET) etc. as raw material component have been examined, but there has been shown a tendency of demonstrating white turbiness of a base material film after drying by heating caused by deposition and crystallization of oligomers existing in the base material film onto a surface of the base material film.

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The paragraph teaches that the polyester film has a tendency of demonstrating turbiness and hence, prior to said tendency, the film is transparent.

Similarly, because the application is directed to transparent adhesive that is acrylic-based and a transparent antistatic layer that have pyrrolidinium ring in the main chain thereof, and that the AU'808 utilizes acrylic-based adhesive and pyrrolidinium ring containing antistatic layer, the adhesive and the antistatic layers of AU'808 will also exhibit transparency, unless shown otherwise by the applicant.

In response to applicant's position that "Applicant makes no admission regarding transparency of the acrylic-based adhesive and the antistatic layer of AU'808", the above explanation regarding the same apply a *fortiori* herein. Further, because the material used by the applicant for the adhesive layer and the anti-static layer are the same as disclosed by AU'808, said corresponding layers of the adhesive and the antistatic layers in the AU'808 will exhibit transparency. Applicant's argument that the presence of printing ink on the adhesive in AU'808 shows that the layer is not transparent, applicant is informed that the printing is directed to a particular embodiment of the polyester film as explained hereinbefore.

Regarding the argument that the film of AU'808 will not necessarily maintain transparency even after one hour heat treatment at 150 degrees C, applicant has merely opined to said effect and not provided with any experimental evidence showing the same.

As for the Malhotra reference, all the explanations provided hereinabove apply a *fortiori* herein. Further, applicant has merely stated that Malhotra does not disclose an

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antistatic layer comprising polymers having pyrrolidinium rings in the main chains but fails to provide any explanations to said effect.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated over the prior art of record discussed above.

5. The following are new grounds of rejection in view of the newly submitted claims 9-12.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9, the negative phrase "not an adhesive layer" is found to be new matter for not having express support in the application as originally filed. The specification teaches that the pyrrolidinium ring containing layer is an antistatic layer but does not support the negative phrase as recited in claim 9.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Australian AU 9640808A.

AU'808 relates to an adhesive polyester film comprising a polyester film and an adhesive coating on at least one side of the film. The adhesive comprises a carboxylic acid group-containing copolymer and one cationic polymer having pyrrolidinium rings in the main chain. When the adhesive is present on both sides of the film, the structure, as interpreted by the examiner, comprises an adhesive layer on one side and the pyrrolidinium ring containing cationic polymer on the other side. The Abstract further mentions that the laminate exhibits excellent antistatic properties. It is also understood by the examiner that the polyester film is transparent, the acrylic based adhesive is transparent and the antistatic layer is also transparent, as is admitted in the instant application.

Further, the laminate would inherently exhibit the maintaining of transparency even after one-hour heat treatment at 150 degrees C.

The intended use phrases such as "for transparent conductive substrates", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

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10. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra (5534374).

Malhotra relates to a laminate (figure-1) comprising a transparent polyester substrate (such as Mylar, which is PET) (2) with adhesive (4) on one side and antistatic layer (41) on the other side. The adhesive can be acrylic-based, which are known to be transparent as admitted by the applicant in the specification, page-8. The antistatic layer comprises a binder and an antistatic agent, such as pyrrolidine acid salt compounds and would be inherently transparent as admitted by the application the specification, page-12. See col. 6, line 62-col. 7, line 10; col. 12, lines 51-63; col. 14, lines 44-46 and 65-68; and col. 30, line 21 – col. 32, line 34.

The laminate will inherently exhibit the maintaining of the transparency as discussed above.

The intended use phrases have not been given any patentable weight as discussed above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Australian AU'808 or Malhotra.

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The Australian AU'808 or Malhotra, as discussed above, discloses that the adhesive thickness is preferably 1 micron but can be of any thickness. However, both AU'808 or Malhotra fails to teach that the thickness of the adhesive layer is 3-10 microns. It would have been obvious to one having ordinary skill in the art to modify the AU'808 or Malhotra reference by providing the adhesive thickness to be 3-100 microns, based on optimization through routine experimentation, for optimum adhesiveness.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

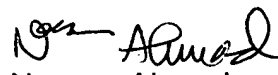
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad
Primary Examiner
Art Unit 1772
9/17/06

N. Ahmad.
September 17, 2006.